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Nokia Corporation and Alston & Bird LLP c/o Alston & Bird LLP Bank of America Plaza, 101 South Tryon Street Suite 4000 Charlotte, NC 28280-4000			EXAMINER YANG, JAMES J	
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* ASHLEY COLLEY

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Appeal 2016-002520  
Application 12/767,367  
Technology Center 2600

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Before JOHN A. EVANS, SCOTT E. BAIN, and  
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

AMUNDSON, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant<sup>1</sup> seeks our review under 35 U.S.C. § 134(a) from a final rejection of claims 1–8, 12–17, 25, and 32–36, i.e., all pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

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<sup>1</sup> According to Appellant, the real party in interest is Nokia Technologies Oy. App. Br. 2.

## STATEMENT OF THE CASE

### *The Invention*

According to the Specification, the invention relates to “an apparatus, method, computer program and user interface configured to be responsive to different types of user input.” Spec. 1:5–8, Abstract.<sup>2</sup> An apparatus according to the invention has a first active state and a second active state and includes a “user selectable part.” Abstract. “[I]n the first active state the user selectable part is actuated in response to a first mode of actuation and in the second active state the user selectable part is not actuated in response to the first mode of actuation.” *Id.*

### *Exemplary Claim*

Independent claim 1 exemplifies the subject matter of the claims under consideration and reads as follows:

1. An apparatus comprising:
  - at least one processor; and
  - at least one memory including computer program code;
  - the at least one memory and the computer program code are configured to, with the at least one processor, cause the apparatus to:
    - determine that the apparatus is in one of a first active state or a second active state;
    - provide a user selectable part;
    - respond to actuation of the user selectable part in response to a first mode of actuation when the apparatus

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<sup>2</sup> This decision uses the following abbreviations: “Spec.” for the Specification, filed April 26, 2010; “Final Act.” for the Final Office Action, mailed December 31, 2014; “App. Br.” for the Appeal Brief, filed August 3, 2015; “Ans.” for the Examiner’s Answer, mailed October 29, 2015; and “Reply Br.” for the Reply Brief, filed December 29, 2015.

is in the first active state, and differently respond to actuation of the user selectable part in response to a second mode of actuation when the apparatus is in the second active state; and

configure the apparatus to cause a tactile indication to be provided with the user selectable part in response to the first mode of actuation and not in response to the second mode of actuation.

App. Br. 7 (Claims App.).

*The Prior Art Supporting the Rejections on Appeal*

Fyke	US 2008/0303796 A1	Dec. 11, 2008
Vartanian et al. ("Vartanian")	US 2010/0238114 A1	Sept. 23, 2010 (filed Mar. 18, 2009)

*The Rejections on Appeal*

Claims 1–5, 7, 8, 13–17, 25, and 33–36 stand rejected under 35 U.S.C. § 102(b) as anticipated by Fyke. Final Act. 2–9; Ans. 2.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Fyke and Vartanian. Final Act. 10; Ans. 2.

Claims 12 and 32 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Fyke. Final Act. 10–11; Ans. 2.

ANALYSIS

We have reviewed the rejections of claims 1–8, 12–17, 25, and 32–36 in light of Appellant's arguments that the Examiner erred. For the reasons explained below, we concur with Appellant's contention that the Examiner erred in finding that Fyke discloses a "user selectable part" according to independent claims 1, 13, and 25.

*The Rejection of Claims 1–5, 7, 8, 13–17, 25, and  
33–36 Under 35 U.S.C. § 102(b) Based on Fyke*

“USER SELECTABLE PART”

Appellant argues that the Examiner erred in rejecting independent claims 1, 13, and 25 because Fyke “does not teach or suggest that the same user selectable part is used in both first and second modes of operation with different functions performed in response to actuation of the same user selectable part in the first and second modes of operation” according to the independent claims. App. Br. 5. In particular, Appellant contends that Fyke differs from the independent claims because a user in Fyke employs “different combinations of virtual keypads and/or physical keys” for different modes of operation and “the virtual keypad and the physical keys [in Fyke] are alternative types of user selectable parts” rather than the same user selectable part. *Id.* at 5–6.

Appellant also argues that because Fyke fails to “teach or suggest that the same user selectable part is used in both first and second modes of operation with different functions performed in response to actuation of the same user selectable part in the first and second modes of operation,” Fyke also fails to “teach or suggest causing a tactile indication to be provided with the user selectable part in response to the first mode of actuation and not in response to the second mode of actuation, as also recited by the independent claims.” App. Br. 6. Appellant contends that a tactile indication in Fyke “is either always provided for a user selectable element . . . or is never provided for a user selectable element” and, therefore, “the tactile indication does not vary for the same user selectable part depending upon the mode of operation as recited by the independent claims.” *Id.*

The Examiner finds that Fyke teaches a wireless handheld device having a display with a touch screen key arrangement (virtual keys) and a physical keyboard. Final Act. 2–3 (citing Fyke ¶¶ 32, 37, 46–48, Fig. 2A); *see* Fyke ¶¶ 31, 47, Fig. 15; *see also* Ans. 3. The Examiner further finds that the touch screen key arrangement and the physical keyboard “together form a user selectable part.” Final Act. 3; *see* Ans. 3. The Examiner reasons that in Fyke “a first active state occurs when touch screen buttons are actuated, and a second active state occurs when physical buttons are actuated.” Ans. 3 (citations omitted); *see* Final Act. 3.

In response, Appellant asserts that the Examiner employs an “incorrect and overly broad” interpretation of “user selectable part” that does not comport with “the manner in which the user selectable part is described by the present application and, as a result, the manner in which a person of ordinary skill in the art would interpret a user selectable part in light of the disclosure provided by the present application.” Reply Br. 1–2; *see* App. Br. 5. Appellant also asserts that “the present application distinguishes between a user selectable part embodied by a touch sensitive display and a user selectable part embodied by a physical key pad.” Reply Br. 1–2.

We agree with Appellant that the Examiner employs an unreasonably broad interpretation of “user selectable part.” *See In re Abbott Diabetes Care Inc.*, 696 F.3d 1142, 1149–50 (Fed. Cir. 2012) (vacating Board decision due to Board’s unreasonably broad claim interpretation). “[D]uring examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.” *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000). Here, the Specification explains that a user input device “may comprise a keypad or a portion of a touch sensitive display or a

combination of” different input components. Spec. 8:26–28. The Specification also explains that “[t]he user selectable part 63 may comprise any part of a user input device 13 which may be actuated and in response to the actuation provide a control signal . . . .” Spec. 13:15–17. The Specification then explains that a “plurality of user selectable parts 61, 63, 65 may be provided simultaneously” and “may comprise portions of a touch sensitive display . . . [or] a plurality of keys in a key pad.” *Id.* 13:17–22. According to the Specification, a “user selectable part” does not encompass an entire touch screen key arrangement together with an entire physical keyboard.

#### SUMMARY

Based on the record before us, the Examiner has not adequately explained how the cited portions of Fyke disclose a “user selectable part” as properly interpreted in independent claims 1, 13, and 25. Thus, we do not sustain the anticipation rejection of these independent claims based on Fyke.

Claims 2–5, 7, 8, 33, and 34 depend from claim 1; claims 14–17 and 35 depend from claim 13; and claim 36 depends from claim 25. For the reasons discussed above regarding the independent claims, we do not sustain the anticipation rejection of these dependent claims based on Fyke.

#### *The Rejection of Claims 12 and 32 Under 35 U.S.C. § 103(a) Based on Fyke*

Claims 12 and 32 depend from claim 1. For the reasons discussed above regarding the anticipation rejection of claim 1, we do not sustain the obviousness rejection of these dependent claims based on Fyke.

*The Rejection of Claim 6 Under 35 U.S.C.  
§ 103(a) Based on Fyke and Vartanian*

Claim 6 depends from claim 1. On the record before us, the Examiner has not shown how the additionally cited Vartanian reference overcomes the deficiency in Fyke with respect to claim 1. Hence, we do not sustain the obviousness rejection of claim 6 based on Fyke and Vartanian.

DECISION

We reverse the Examiner's decision to reject claims 1–8, 12–17, 25, and 32–36.

REVERSED